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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,721	02/06/2002	Kiyotaka Matsuno	15252	1963
7590 05/18/2005				
Scully, Scott, Murphy & Presser 400 Garden City Plaza Garden City, NY 11530				
			EXAMINER	
			MENDOZA, MICHAEL G	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/072,721	<b>Applicant(s)</b> MATSUNO ET AL.	
	<b>Examiner</b> Michael G. Mendoza	<b>Art Unit</b> 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 6-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 28 February 2005 have been fully considered but they are not persuasive. The Applicant argues that Komiya does not teach that the clip is separated in a closed state from the coupling member when the operation wire is being pulled. However, Komiya teaches that the clip is left in the body. The clip is disengaged from the hook and wire of Komiya then the pulled out of the body (col. 5, 14-31). Furthermore, new limitation did not result in a structural difference. The structural limitations of a sheath member, operation member, and a clip are met by Komiya.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 7, 8, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Komiya 3958576.

4. Komiya teaches a clipping device comprising: a sheath member 15; an operation wire 19 inserted into the sheath; a coupling member 20; a clip 11; wherein the operation wire and the coupling member are nondetachable (fig. 4); an insertion tube 10 fitted over an outer side of the sheath member; a first operation means mounted near a base end of the insertion tube; and a second operation means having a slider coupled

to a base end of the operation wire (fig. 2); wherein the coupling member has a clip latching hole 21a having an opening.

5. Claims 1, 7, 8, 10, 17, 19, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsuno et al. 5766184.

6. Matsuno et al. teaches a clipping device comprising: a sheath member; an operation wire; a coupling member directly connected to a distal end of the operation wire; a clip detachably coupled to the coupling member and adapted to be closed by a pulling operation of the wire, in which when the coupling member is transformed, the clip is separated in a closed state from the coupling member; an insertion tube 3 fitted over an outer side of the sheath member 28; a first operation means 36 mounted near a base end of the insertion tube; and a second operation means 13 having a slider coupled to a base end of the operation wire; wherein the coupling member has a clip latching hole 51 having an opening (fig. 1b); wherein the strength of the coupling member is so set as to allow the coupling member to be extended after the clip has been retracted into the insertion tube and put into a state in which the tissue can be adequately grasped(col. 12, lines 53-61).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 3, 6, 9, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komiya.

9. Komiya fails to teach wherein the operation wire and coupling member are connected to each other by passing the operation wire through a hole of the coupling member and by turning the operation wire back, or wherein the operation wire and coupling member are connected to each other by cramping. Komiya teaches a one-piece design (fig. 4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to connected the wire and coupling member as recited in the claims because the particulars of the connection are a mere design choice. Furthermore, the Applicant has not disclosed why the particulars of the operation wire are of importance or solve a stated problem or provide an advantage over the prior art.

10. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuno et al.

11. Matsuno et al. disclosed the claimed invention except for the operation wire and coupling member are so fixed as to be nondetachable. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the operation wire and coupling member nondetachable, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involve only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

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12. Claims 11-13 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komiya or Matsuno et al. in view of Jepson et al. 5135489.

13. Komiya and Matsuno et al. both teach the clipping device of claim 7. It should be noted that both Komiya and Matsuno et al. fails to teach wherein the insertion tube has an embossed outer and/or inner surface.

14. Jepson et al. teaches a device with common embossed embossed surfaces for reducing friction. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the embossed surface of Jepson et al. in combination with the insertion tubes of Komiya or Matsuno et al. to reduce friction between moving parts of the device (col. 16, lines 37-51).

#### ***Contacts***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael G. Mendoza whose telephone number is (571) 272-4698. The examiner can normally be reached on Mon.-Fri. 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-44963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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GLENN K. DAWSON  
PRIMARY EXAMINER